

REMARKS

This is a full response to the outstanding Final Office Action, dated March 25, 2005.

1. Summary Of The Rejections

The pending Office Action has been made “final”, yet it now offers a new ground for rejection that has never been made in previous Office Actions. Namely, the Office Action rejects all of the pending claims, 1-22, 26 and 27 under 35 U.S.C. § 103 over previously cited reference U.S. Patent No. 5,835,896 to Fisher (herein after “*Fisher*”) in view of a newly cited reference, U.S. Application Publication No. 2003/0236739 by Borgeson et al., filed March 10, 2003 (the *Borgeson* Publication).

2. Response To Rejection.

The claimed invention predates the newly cited art. This is demonstrated by the attached 37 CFR § 1.131 Affidavit and Exhibits A-E attached thereto.

As admitted in the Final Office Action, *Fisher* does not disclose or suggest all of the elements of any pending claim. Specifically, *Fisher* fails to disclose or suggest at least the element that the auction has at least two or more positions of priority, and the received bid management data includes information for selecting one of the two or more positions of priority that a bidder wishes to maintain in an auction. The Office Action alleges that the newly cited *Borgeson* Publication does disclose this element.

However, the *Borgeson* Publication has a filing date of March 10, 2003, which is more than 3 years after the filing date of the present application, January 1, 2000. The *Borgeson* Publication does refer to two other applications in its Related U.S. Application

Data section. It purports to be a continuation of U.S. Application No. 09/836,118 (the Parent '118 Application), filed March 27, 2000, which is a date that is still more than 2 months after the present application was filed. The *Borgeson* Publication further alleges that the '118 Application is "based upon provisional application serial No. 60/172,084" (the '028 Provisional Application), which has a filing date of December 23, 1999.

Nevertheless, the Examiner relies on the disclosure of the *Borgeson* Publication having a filing date of March 10, 2003. Since the Parent '118 Application was filed after the Applicant's filing date, the Final Office Action must rely solely on the proposition that the '028 Provisional Application discloses the same material that is referred to in the *Borgeson* Publication as a basis for the 35 U.S.C. § 103 rejection.

However, the '028 Provisional Application does not necessarily disclose the same subject matter included in every part of its non-provisional counterpart applications, including the *Borgeson* Publication. In this regard, the Final Office Action fails to sufficiently explain or illustrate which parts of the '028 Provisional Application show at least the same matter referred to in the *Borgeson* Publication as a bases for the 35 U.S.C. § 103 rejection.

Finally, regarding the '028 Provisional Application, even if it the bases for rejection were sufficiently explained, as shown by the attached 37 CFR § 1.131 Affidavit (See Exhibits A-E), the Applicant swears behind the '028 Provisional Application (and therefore all of the applications in the family of the *Borgeson* Publication). As such neither the *Borgeson* Publication, the Parent '118 Application, nor '028 Provisional Application are prior art to the claimed invention.

CONCLUSION

Applicant has made an earnest and bona fide effort to clarify the issues before the Examiner and to place this case in condition for allowance. In view of the foregoing discussions, it is clear that the newly cited art that is used in the Final Office Action as basis for the rejection is not actually prior art. The other art cited by the Final Office Action was addressed and traversed in previous Office Actions. Thus, the claimed invention is patentably distinct over the prior art. Therefore, reconsideration and allowance of all of claims 1-22 and 26-27 is believed to be in order, and an early Notice of Allowance to this effect is respectfully requested.

Respectfully submitted,

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